



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,698	02/02/2000	ANDREW D. Simchik	XXT-036CP	6586

7590 11/08/2004

Patrick R Roche
Fay, Sharpe, Fagan, Minnich & McKee LLP
1100 Superior Avenue
7th Floor
Cleveland, OH 44114-2518

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT PAPER NUMBER

2622

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/496,698

Applicant(s)

SIMCHIK ET AL.

Examiner

Joseph R. Pokrzywa

Art Unit

2622

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: The amendment raises new issues in claims 13 and 16.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-23.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Joseph R. Pokrzywa
JOSEPH R. POKRZYWA
EXAMINER
ART UNIT 2622

DETAILED ACTION

Period for Reply

1. The shortened statutory period for reply expires THREE MONTHS from the mailing date of the final rejection or as of the mailing date of this advisory action, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for reply expires as set forth above.

Response to Amendment

2. The amendment filed 9/16/04 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

- a. The proposed amendment is not deemed to place the application in better form for appeal by materially simplifying the issues for appeal.
- b. The proposed amendment raises new issues that would require further consideration and/or search.

Regarding independent *claim 13*, the addition of the limitation that requires "converting an existing page into image data suitable for subsequent dynamic and automatic assembly into a

document”, raises new issues, therein changing the scope of the claim, thus requiring further consideration and search.

Regarding dependent *claim 16*, the addition of the limitation that requires “importing the image file into the document dynamically and automatically without user interaction”, raises new issues, therein changing the scope of the claim, thus requiring further consideration and search.

Response to Arguments

3. Applicant's arguments filed 9/16/04 have been fully considered but they are not persuasive.

4. In response to applicant's arguments regarding the rejection of claim 1, which was cited as being anticipated by Robertson *et al.* (U.S. Patent Number 6,507,410), whereby applicant argues on page 7 that Robertson fails to teach of translating the PDL file into an image file representative of the page suitable for assembly into the document. Further, applicant argues on pages 7 and 8 that Robertson fairly suggest importing the existing page from the network into the printing system, translating the existing page from the network into a PDL file representative of the page and translating the PDL into an image file representative of the page and suitable for assembly into the document. Robertson shows in Fig. 2, steps 101-104, and in column 10, lines 7 through 53 of importing an existing web page from a network into the printing system. Continuing, Robertson teaches in column 18, line 62-column 19, line 3, and in step 170 of Fig. 12 (being a more detailed description of the processing seen in step 109 of Fig. 2), that a document is created and formatted in a page description language. Further, in steps 172-178, and in column 18, lines 4-40, Robertson teaches that a cutting template is concatenated with the

created PDL file, and then transmitted to the printer. Thus, the PDL file is translated into an image file suitable for assembly into a document. The assembled document is shown in 9, whereby in column 19, lines 38-40, Robertson states that the “resulting document may include physical hyperlinks in patterns not dissimilar to the example shown in Fig. 9”.

5. Therefore, the rejection of **claim 1**, as well as dependent **claims 2-7**, as cited in the Office action dated 7/14/04, under 35 U.S.C.102(e) as being anticipated by Robertson *et al.*, is maintained.

6. In response to applicant’s arguments regarding the rejection of claim 8, whereby applicant argues on page 9 that Robertson fails to teach of inserting a link into the document, the link corresponding to a page in the network, launching a browser in response to the link, retrieving the page from the network, translating the page into a PDL file, and converting the PDL file into an image file suitable for insertion into the document. Robertson teaches of inserting a link into the document, as seen in Fig. 2, steps 102-107, with the link corresponding to a page present in the network, as read in column 5, line 55 through column 6, line 19, and column 12, lines 24 through 55. Continuing, Robertson teaches of launching a browser in response to the link, as read in column 15, line 51 through column 16, line 9, wherein a browser would inherently be used to activate the hyperlink in the document. Further, Robertson teaches of retrieving the page from the network, as seen in Fig. 3, and read in column 4, lines 34 through 57, and column 10, lines 7 through 53. Finally, as seen in Fig. 12 and read in column 10, lines 54 through column 11, line 55, and column 18, line 62 through column 19, line 37, Robertson teaches of converting the page into an image file suitable for insertion into the document.

7. Therefore, the rejection of **claim 8**, as well as dependent **claims 9-12**, as cited in the Office action dated 7/14/04, under 35 U.S.C.102(e) as being anticipated by Robertson *et al.*, is maintained.

8. In response to applicant's arguments regarding the rejections of claims 13, 20, and 23, whereby applicant argues on pages 9 and 10 that Robertson fails to teach of converting an existing page from a network into image data suitable for subsequent, dynamic and automatic assembly into a document generated by a document creation algorithm. The examiner notes that the above limitation was added into claim 13 in this amendment, and in each of the claims appears in the preamble of the claim. Thus, the recitation of "subsequent, dynamic and automatic assembly" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further, as seen in Fig. 2, steps 104-108, Robertson still teaches of converting an existing web page into image data for subsequent, dynamic and automatic assembly into a document.

9. Therefore, the rejection of independent **claims 13, 20, and 23**, as well as their corresponding dependent **claims 14-19, 21, and 22**, as cited in the Office action dated 7/14/04, under 35 U.S.C.102(e) as being anticipated by Robertson *et al.*, is maintained.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Examiner
Art Unit 2622



jrp